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Paper No. 58

Emma R. Dailey
WOODCOCK WASHBURN KURTZ MACKIEWICZ & NORRIS LLP
One Liberty Place
46th Floor
Philadelphia, PA 19103

COPY MAILED

In re Application of	:	DEC 09 2004
Smith et al.	:	
Application No. 08/392,934	:	DECISION
International Filing Date:	:	OFFICE OF PETITIONS
September 15, 1993	:	ON PETITION
371 Date: October 28, 1996	:	
Title of Invention:	:	
IMMUNOREACTIVE PEPTIDES FROM	:	
EPSTEIN-BARR VIRUS	:	

This is a decision in response to the Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b), filed November 30, 2004.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. **This time period may not be extended.**

Background:

Applicant filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on December 18, 2001, in the above-identified application, which is the National Stage of an International Application filed on September 15, 1993. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e)(3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure

(MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on June 28, 2001. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of notice of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on December 18, 2001, did not toll the time period set forth in the Office action mailed on June 28, 2001. Thus, the application became **abandoned on December 29, 2001** for the failure to reply to the final Office action mailed on June 28, 2001.

The Office, however, mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A Supplemental Response was filed December 18, 2001. A non-final Office action was mailed on March 8, 2002. A reply to the non-final Office action was filed on August 12, 2002. An Ex Parte Quayle action was mailed October 29, 2002. An Amendment in response to the Ex Parte Quayle action was filed on December 2, 2002. A Notice of Allowance was mailed on February 20, 2003.

Applicant was advised in a Notice Regarding Improper RCE, mailed November 5, 2004, that the RCE was improper, and advised to file a petition under 37 CFR 1.137(b) and a terminal disclaimer and fee as set forth in 37 CFR 1.321 because the application was filed before June 8, 1995.

The instant petition

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed); (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) if required, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). Applicant lacks item (1).

As to item (4), Applicant files the instant petition but has failed to include the terminal disclaimer as required by 37 CFR 1.137(d). A terminal disclaimer and fee as set forth in 37 CFR 1.321 is required.


Any request for reconsideration of petition under 37 CFR 1.137(b) should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: 220 20th Street S.
 Customer Window
 Crystal Plaza Two, Lobby Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this Notice should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney Advisor
Office of Petitions